

REMARKS/ARGUMENTS

The claims are 1-10. Claim 1 has been amended to better define the invention, and claim 4 has been amended in view of the amendment to claim 1. In addition, claim 10 has been amended to better define the invention. Support for the claims may be found, *inter alia*, in the original claims and FIG. 1a. Reconsideration is expressly requested.

Applicants wish to thank the Examiner for the courtesy of a telephone conference on September 24, 2008, the substance to which is set forth herein. The Office Action Summary had both boxes 2a and 2b checked indicating that the action was both final and non-final. During the September 24, 2008 telephone conference, the Examiner indicated that the box "2a" had been marked by mistake and that the Office Action was a non-final Office Action.

Claim 10 was objected to as lacking positive recitation of the grip end being lockable into the proximal end of the biopsy cannula. Claim 10 was rejected under 35 U.S.C. 112, second paragraph, for similar reasons.

In response, Applicants have amended claim 10 to correct this informality which it is respectfully submitted overcomes the Examiner's rejection to claim 10 on the basis of these formal grounds.

Claims 1-7 and 9 were rejected under 35 U.S.C. 102(b) as being anticipated by *Miller et al. U.S. Patent No. 6,416,484*. The remaining claims were rejected under 35 U.S.C. 103(a) as being unpatentable over *Miller et al.* in view of *Janese U.S. Patent No. 4,781,202* (claim 8), or *Miller et al.* alone or alternatively *Miller et al.* in view of *Janese* (claim 10).

Essentially the Examiner's position was that *Miller et al.* discloses the biopsy material holding device recited in the claims, except for features which were considered either within the skill of the art or taught by the secondary reference to *Janese*.

This rejection is respectfully traversed.

As set forth in claim 1 as amended, Applicants' invention provides a biopsy material holding device for a biopsy cannula

insertable into a proximal end of a biopsy cannula and between an inner wall of the biopsy cannula and a tissue-removing cylinder to perform transcutaneous biopsies of tissues. The biopsy material holding device includes a wire having a proximal end, a distal end, and a wire tip at the distal end with bevelling arranged at the wire tip. The wire is bent in a bending direction at a pre-stress angle arranged at the proximate end of the wire, and the bevelling faces away from the bending direction, so that the wire including the wire tip glides along the inner wall of the biopsy cannula when inserted into the biopsy cannula.

The primary reference to *Miller et al.* fails to disclose or suggest a biopsy holder that is formed by a wire to be introduced in the cannula. The distal part of the biopsy extractor disclosed in *Miller et al.* has a cutting tip in the form of a blade or shovel that is linked to the body portion by a narrow hinge. Although the Examiner considers this narrow hinge portion to be the wire, it is respectfully submitted that the Examiner's position is incorrect in that there is no wire disclosed in *Miller et al.*.

The defects and deficiencies of the primary reference to *Miller et al.* are nowhere remedied by the secondary reference to *Janese*. Although *Janese* discloses a biopsy holder in the form of a wire (see FIGS. 2a and 2b of *Janese*), the *Janese* biopsy holder differs from Applicants' biopsy material holding device as recited in claim 1, as amended, in that in Applicants' biopsy holder the beveling arranged at the distal end of the wire faces away from the direction of bending, whereas the beveling at the end of the wire of *Janese* faces into the direction of beveling. It is important that the beveling of the wire faces away from the direction of bending as recited in Applicants' claim 1, as amended, because the unbeveled side of the wire is intended to glide along an outer wall of a biopsy cannula. With Applicants' arrangement as recited in claim 1 as amended, the beveling avoids the sharp wire hunkering the biopsy material cylinder inside the biopsy cannula.

It is respectfully submitted that the beveling cannot be considered obvious and in fact is shown to be nonobvious by the secondary reference to *Janese* itself in that *Janese* teaches exactly the opposite direction of beveling. Accordingly, it is respectfully submitted that claim 1 as amended, together with

claims 2-10, which depend directly or indirectly thereon, define patentable or unobvious subject matter.

In summary, claims 1, 4 and 10 have been amended. In view of the foregoing, it is respectfully requested that the claims be allowed and that this case be passed to issue.

Applicants also respectfully request that *Miller et al.*, cited by the Examiner in the September 15, 2008 Office Action but not listed on the form PTO-892 attached thereto, be formally made of record by the Examiner by listing it on a Notice of References cited form PTO-892.

Respectfully submitted,
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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 20, 2008.

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